



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,415	11/07/2001	Mitchell D. Eggers	GENV-004/00US 300805-2007	9374
58249 7590 09/02/2008 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			EXAMINER HARRELL, ROBERT B	
			ART UNIT 2142	PAPER NUMBER
			MAIL DATE 09/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/005,415	Applicant(s) EGGERS, MITCHELL D.	
	Examiner Robert B. Harrell	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080604</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

Art Unit: 2142

1. Claims 1-64 remain presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are now directed.
3. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim (i.e., see claim 57 "The method")). Also, claim numbers should not be super or subscripted text (see claim 17 for example). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).
5. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).
6. **Claims 1-64 of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-36 of United States Patent 7,142,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because the United States Patent 7,142,987 claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains and is thus therein residing within the scope of United States Patent 7,142,987.
7. **Claims 1-64 of this United States Application, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over

Art Unit: 2142

claims 1-40 and 58-69 of United States Patent Application 10/007,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/007,355 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains and is thus therein residing within the scope of United States Patent 10/007,355 application claims. This is a provisional rejection since neither applications have yet been allowed.

8. **Claims 1-64 of this United States Application, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-64 and 86-117 of United States Patent Application 10/150,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/150,771 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains and is thus therein residing within the scope of United States Patent 10/150,771 application claims. This is a provisional rejection since neither application have yet been allowed. This is a provisional rejection since neither applications have yet been allowed.

9. **Claims 1-64 of this United States Application, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1, 2, 4-11, 13-16, 35-42, and 44-51 of United States Patent Application 10/252,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/252,352 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains and is thus therein residing within the scope of United States Patent 10/252,352 application claims. This is a provisional rejection since neither application have yet been allowed. This is a provisional rejection since neither applications have yet been allowed.

10. In response to the above rejections under the judicially created doctrine of obviousness-type double patenting, the applicant filed a terminal disclaimer with respect to United States Patent 7,142,987, and argued, with supporting sections of the MPEP, for the remaining pending applications. However, the terminal disclaimer has no initialized marking near "Gen/" and thus the strike is unknown to be a stray mark or correction. A new terminal disclaimer with correct typing is required to overcome the above stated rejection. As for the other pending claims, such sections of the MPEP have been reviewed and noted; however, for the reasons outlined below, the above stated rejections are not the only remaining rejections.

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 1-64 are rejected under 35 U.S.C. 101** because the claimed invention, in light of the specification, encompasses non-statutory subject matter since such reads on (encompass)

Art Unit: 2142

software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A method" or "A computerized method" each of the recited elements encompass their software or program per se' equivalent (i.e., a client such as a Netscape Web Browser and/or a server such as Apache are each software devices and yet phrased as a client and a server); thus, the whole of the method encompasses pure software or program per se'. Specifically, claims 14-26 encompasses only human acts; unlike "A computerized method executing on a hardware" for all method claims. Also, while a hardware device claim, with functional acts, may inherently encompass a corresponding method, the same does not hold in the reverse since a corresponding method is broader in scope and can encompass a scope void of any hardware. As for the system claims, such encompass only software or program per se' equivalents; unlike "A hardware system"; the applicant is reminded that an Operating System is software and/or program per se'. The applicant is also reminded of the constant flux in this area of Law with respect to CACF and the United States Supreme Court that now calls for the rejection of the claims herein under 35 U.S.C. 101

13. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 1-64 are rejected under 35 U.S.C 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

a) "The method"--claim 57 (claim 56 is a system).

15. As to 16 (a) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as **non-responsive**. Nonetheless, should a response yield all claims allowable short **a few** cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of

Art Unit: 2142

allowance by the applicant. Also, "its" cannot be clearly associated with a corresponding proper noun antecedent (i.e., see claim 61 as but one example).

16. Per claims 1-64, it cannot be clearly ascertained if the claims encompass only hardware, or software, or a combination since there is no clear recital of actual hardware.

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. **Claims 1-64 are rejected under 35 U.S.C. 102 (b)** as being anticipated by Layne et al. (United States Patent Number 5,968,731).

19. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions. Also, Layne was cited on PTO-FORM 1449, as filed 05 April 2004 (page 1 of 2) labeled as reference "BR"; hence a PTO-FORM 892 is not required by the Office.

20. Per claim 1, Layne taught a method (e.g., see figure 11 and figure 12) of providing biological analyses (e.g., see Title) to a remote client (e.g., see Abstract, figure 4, and figure 5); said method comprising:

- a) providing a plurality of discrete sample nodes (e.g., see figure 7 (212), figure 9 (252) and the array under element 256)) each configured to receive a discrete sample (i.e., see figure 7 (test tubes under element 206, element 208, and element 210)) and removably attached at a corresponding attachment point (e.g., see figure 7 (212)) in a predetermined spatial relationship with other discrete sample nodes on a sample structure (e.g., see microarray in figure 7 (212));
- b) transferring a sample to each of said plurality of discrete sample nodes independently of sample transfers to the other discrete sample nodes wherein the corresponding attachment point of each discrete sample node is maintained free of sample material (e.g., see Abstract, figure 5, figure 6, figure 7, and col. 8 (line 44-et seq.)) ;
- c) maintaining said plurality of discrete sample nodes in a sample archive (e.g., see figure 5, figure 6, figure 7, and col. 8 (line 44-et seq.));

Art Unit: 2142

- d) receiving a request for a biological analysis from a remote client (e.g., see Abstract, figure 11, figure 12, and col. 8 (line 17-et seq.));
- e) said request comprising identification of a desired one of said plurality of discrete sample nodes and identification of a selected assay (e.g., see Abstract, figure 11, figure 12, and col. 8 (line 17-et seq.));
- f) responsive to said receiving, retrieving said desired discrete sample node from said archive and preparing said selected assay e.g., see Abstract, figure 11, figure 12, and col. 8 (line 17-et seq.)); and,
- g) performing said selected assay for said desired discrete sample node e.g., see Abstract, figure 11, figure 12, and col. 8 (line 17-et seq.)).

21. Per claim 2, claim 3, claim 4, claim 5, claim 6, claim 7, claim 8, claim 9, claim 10, claim 11, claim 12 and claim 13 see figure 11 (318) for transmitting results to the remote client and col. 8 (line 17-et seq.) for a network connection(s). As for sending the sample to the remote client, it was clearly anticipated that anything could be shipped to anyone in such a system as covered by Layne per figure 4 (104 “Express”) by packaging samples. See col. 2 (line 11-et seq.) for genomics and proteomics experiment(s). See also figure 11 (320), as an example for database teachings and figure 9 (256) for optical sensor in a sample node removal device per figure 7. Since biological samples were being tested, lasers (i.e. figure 9 (256) and mechanical clipping tools were anticipated as part of the lab in figure 4 and figure 6 as claimed by the applicant. See figure 7 (“washing”) for washing. As for encryption, since patient sensitive data was being transmitted (i.e., via the Internet) use of SSL was not only encompassed by “Internet” but anticipated for privacy over a very public network. Also see figure 4 (104 “Storage) for archival of samples, figure 6 for processor control, col. 3 (line 62-et seq.) for assay and processor controller for transmitting control signals to the sample carrier retrieval devices.

22. Per claims 14-64, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. As for the number of samples per day, such was anticipated to be dependent on the amount of hardware as for example in figure (134). As for radially, see figure 7 (212) starting from the center and spiraling outwards (i.e., the square encompasses a circular pattern there within); and, when stacked, a sphere; also, such was a matter of anticipated design choice by those skilled in the art.

Art Unit: 2142

23. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

/Robert B. Harrell/
ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142